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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,807	05/31/2007	Binghe Wang	24W01.1-011	4895

23506 7590 05/12/2009
GARDNER GROFF GREENWALD & VILLANUEVA. PC
2018 POWERS FERRY ROAD
SUITE 800
ATLANTA, GA 30339

EXAMINER

CHANDRAKUMAR, NIZAL S

ART UNIT	PAPER NUMBER
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1625

NOTIFICATION DATE	DELIVERY MODE
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05/12/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@gardnergroff.com
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Office Action Summary	Application No. 10/570,807	Applicant(s) WANG ET AL.	
	Examiner NIZAL S. CHANDRAKUMAR	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-112 is/are pending in the application.
- 4a) Of the above claim(s) 2-112 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/06/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application is a 371 of PCT/US04/28838 09/07/2004
which claims benefit of 60/500,785 09/05/2003

Election/Restrictions

Applicant's election with traverse of Group II

(Group II) drawn to quinolin-8-ylboronic acid, quinolin-5-ylboronic acid, 2-(4-boronophenyl)quinoline-4-carboxylic acid, 2-((methylamino)methyl)quinolin-8-ylboronic acid.

in the reply filed on 03/06/2009 is acknowledged. The traversal is on the ground(s) that Groups I-III have common structural features of formula II and further it would not be serious burden to search Groups VI-IX as these claims recite the use of compounds of formula II. This is not found persuasive because the compounds and inventions of the different groups are classified differently and a patent search for one group of compounds would not be coextensive with the one required for the others.

The requirement is still deemed proper and is therefore made FINAL.

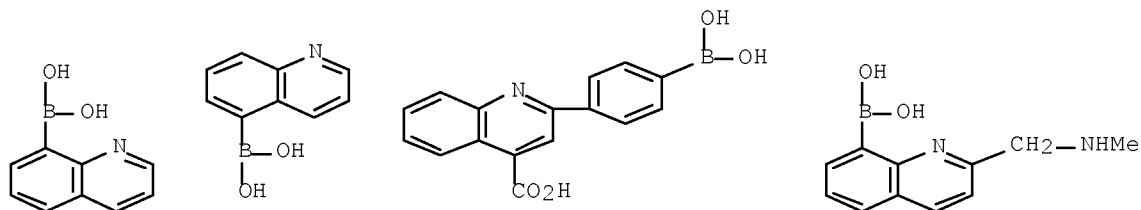
Applicants did not identify the claims encompassing the specific four compounds of the elected Group II. An explicit request for identification of claims encompassing the elected invention was made in the Restriction Requirement filed 02/09/2009 page 7, lines 12-15.

On 03/23/2009, in a telephone interview with Lawrence Villanueva attorney for the applicant, the election of Group II drawn to four specific compounds was confirmed.

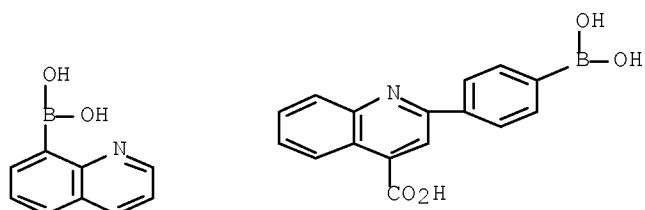
There are 122 claims pending of which claims 1-26 are drawn to compounds.

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The elected Group II is drawn to four specific compounds



of which

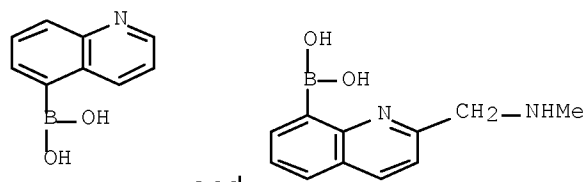


and

are excluded from the base claim 1 by

proviso.

As such the remaining compounds of the elected Group II are



and

and these are examined for

patentability.

Examiner identifies claim 1 to encompass the elected compounds under prosecution.

Claims 2-122 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking

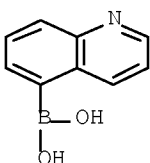
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claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 03/06/2009.

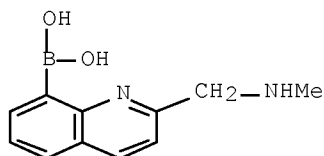
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Allowable Subject Matter

Compounds under prosecution



and



are free of prior art.

Claim 1 is objected to for containing non-elected subject matter and would be allowable rewritten to limit to these two compounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIZAL S. CHANDRAKUMAR whose telephone number is (571)272-6202. The examiner can normally be reached on 8.30 AM - 4.30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571 0272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nizal S Chandrakumar/
Examiner, Art Unit 1625

/D. Margaret Seaman/

Primary Examiner, Art Unit 1625